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EXAMINER

LEE, CHEUKFAN

ART UNIT PAPER NUMBER

2622

DATE MAILED: 09/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/668.564

Applicant(s)

Examiner

Cheukfan Lee

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 9-22-00
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 16 and 17 is/are allowed.
- ☒ Claim(s) 1, 2, 4-7, 9-15, and 18-20 is/are rejected.
- ☒ Claim(s) 3 and 8 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. Claims 1-20 are pending. Claims 1, 16, 18, and 19 are independent.
2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 9, 18, and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10, 19, and 20,

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respectively, of copending Application No. 09/696,719. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 claims all limitations of claim 1 of '719, except for the difference in a few terms between the two claims. Claim 1 recites "Greeting card making apparatus" on line 1 of the claim and "a layout template that defines a layout area" on line 3 of the claim, whereas claim 1 of '719 recites "Collage making apparatus" on line 1 of the claim and "a layout area contained within said collage making apparatus" of lines 3-4. A collage is a collection of images, or is, as defined by Webster's II New Reversible University Dictionary, "an artistic composition of objects and materials pasted over a surface". Usually, a greeting card contains one or more objects or images printed thereon. One of ordinary skill in the art would have realized that the greeting card is a kind of a collage. Therefore, with a collage, it would have been obvious to one of ordinary skill in the art to make a greeting card.

With regard to the layout template, claim 1 uses the template to defines the layout area. Claim 1 of '719 recites a layout area contained in the collage making apparatus. One of ordinary skill in the art would have realized the benefit of using template to define the layout area of claim 1 of '719, i.e., the benefit of better organizing the object or objects in the layout area of claim 1 of '719. It would have been obvious to employ a layout template to define the layout area to better organize the objects on the layout area.

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Claim 9 recites the limitations of claim 10 of '719.

Claim 18 recites the limitations of claim 19 of '719, except for the use of the term "greeting card" in place of "collage" of claim 19 of '719 and the use of "a object positioning and orientation means for positioning and orienting at least one object that is to be contained in said greeting card" in place of "a layout area contained with said collage marking means, said layout area accommodating at least one object that is to be contained in said collage." In managing at least one objects to be reproduced by the duplication apparatus, one of ordinary skill in the art would have realized the advantage of having means for positioning and orienting the at least one object, which is well organizing the at least one object. Therefore, it would have been obvious to one of ordinary skill in the art to employ object positioning and orientation means for positioning and orienting the at least one object accommodated in the layout area of claim 19 of '719 to well organize the at least one objects as claimed in claim 18. Further, with regard to the difference between the "greeting card" of the claim and "collage" of claim 19 of '719, it would have been obvious to one of ordinary skill in the art to make a greeting card as claimed for the reason of obviousness given for claim 1 above.

Claim 19 recites all limitations of the claim 20 of '719, except for the use of the term "greeting card" in place of the term "collage". With the collage of claim 20 of '719, it would have been obvious to one of ordinary skill in the art to make a greeting card as claimed with the collage of claim 20 of '719 for the reasons of obviousness given for claim 1 above.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4-7, 9-15, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. (U.S. Patent No. 6,043,866).

Regarding claim 1, Kawai et al. discloses an original carrier used with an original scanner (col. 3, line 59 - col. 9, line 20). The carrier (Figs. 1, 2, and 4-20) has an opaque sheet (1) and a transparent sheet (2). An original to be scanned is placed between the sheets (1 and 2). The carrier has a layout template (within an area of 1) (Figs. 1, 2, 5-8, 12-14, and 17-20) that defines a layout area accommodating at least one object that is to be contained in the produced copy. The carrier is convertible between a layout mode and a duplication mode. In the layout mode, the layout area is observable by a user so that the user may observe an arrangement of the object(s) within the layout area. In the duplication mode, the carrier with the arranged original(s) or object(s) are scanned to produce a copy of the arrangement.

Kawai et al. does not explicitly disclose making a greeting card using the produced copy of the arranged original(s) or object(s). Since the original or object being reproduced includes a postcard with a photograph, i.e., not just text (Figs. 5-8 and 18), One of ordinary skill in the art would have realized that a greeting card is produced when such a produced copy is folded.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make a greeting card using the produced copy of Kawai et al. by folding the produced copy of the original(s) or object(s) to make variety of uses of the scanner or duplication apparatus.

Regarding claim 2, a position and orientation of at least one original or object in the layout area defined (Figs. 1, 2, 5-7, 12-14, and 17-20).

Regarding claims 4 and 6, according to Figs. 6-8, at least one opening is provided with elements (2a, 2b, 2c, etc.) in the layout area.

Regarding claim 5, the transparent sheet (2) reads on the claimed backing member.

Regarding claim 7, the transparent sheet (2) can be moved between a first or open position and a second or closed position. The transparent sheet (2) also secures the original(s) when in the second or closed position.

Regarding claim 9, the transparent sheet (2 or 32) and the template sheet (1 or 31) are temporarily secured to each other in the scanning or reading operation (col. 8, lines 46-55).

Regarding claim 10, Kawai et al. specifically discloses the thickness and rigidity of the transparent sheet (2), in addition to the kind of material of the carrier sheets as being "preferably" or "desirably" "plastic" (col. 3, lines 65-66, col. 4, lines 37-41, col. 5, lines 10-13, col. 7, lines 23-26). However, nowhere in the disclosure of Kawai et al. places any limitation in the thickness of the opaque sheet (1). Thus, one of ordinary skill in the art would have realized the benefit of using less expensive material such as cardboard to form the layout template, as long as the

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cardboard is made the thickness of the plastic lower sheet (1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use inexpensive material to form the template of the Kawai et al. to reduce the cost of the carrier.

Regarding claim 11, the carrier including the layout template is made of plastic material (col. 3, lines 65-66, col. 4, lines 37-41, col. 5, lines 10-13, and col. 7, lines 23-26).

Regarding claims 12-15, according to Figs. 5 and 6, when the produced copy is folded to produce a greeting card for the obviousness reason given for claim 1 above, the at least one object is contained in one of the specific portions of the greeting card, a front outer portion, a front inner portion, a back inner portion, and a back outer portion, depending on how the card is folded and the direction the objects placed in the layout area.

Regarding claim 18, see discussion for claim 1. In addition, based on the reason of obviousness given for claim 1, the obvious greeting card making apparatus (of Kawai et al.) defines object positioning and orientation.

Claims 19 and 20 are rejected as method claims corresponding to the rejected apparatus claim 1.

6. Claims 3 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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7. Claims 16 and 17 are allowed.

8. The following is an examiner's statement of reasons for allowance:

Claim 3 would be allowable because Kawai et al. does not disclose a recessed area in the layout area.

Claim 8 would be allowable because Kawai et al. does not disclose a combination of the layout template, the backing member and the transparent cover. In the rejections addressed above, the transparent sheet (2) reads on the backing member in one claim or on the transparent cover in another claim but does not meet both the backing member and the transparent member when the both are recited in the same claim which is claim 8.

Claims 16 and 17 are allowable because Kawai et al. does not disclose an aperture grille operatably associated with the backing member that defines a layout area which accommodates at least one object that is to be contained in a greeting card, the aperture grille including at least one opening therein, in combination with other limitations of claim 16. The template of Kawai et al. is not an aperture grille. Claim 17 depends on claim 16.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee at telephone number (703) 305-4867.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)
(703) 308-5397 (for informal or draft communications, such as proposed
amendments to be discussed at an interview; please label such communications
"PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA
Sixth Floor (Receptionist)

C. L.
Aug. 21, 2003


cheukfan lee